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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/844,322

Filing Date: April 26, 2001

Appellant(s): NORMAN ET AL.

Daniel Christenbury
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/27/07 appealing from the Office action
mailed 8/17/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appellants filed a Notice of Appeal on July 5, 2005 for U.S. Patent Application Serial No. 09/711,194 filed on April 26, 2001. An official Action dated March 21, 2006 reopened prosecution in that application. The Appeal is being reinstated in that application.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,944,368	O'BRIAN et al.	7-1960
5,607,339	KRAMER	3-1997
5,913,708	GROSS	6-1999
4,294,036	WION	10-1981
6,475,609	WHITNEY	11-2002
5,928,803	YASUDA	07-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 20-23, 25-26 and 28-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-22, 38 and 47 are indefinite since all that the applicant considers to be encompassed by the phrase "in a life-like way" cannot be determined.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3725

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 21-23, 25, 28 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross [5,913,708] in view of Kramer [5,607,339].

Gross discloses in Fig 18, a garment [jumpsuit 180] comprising a flexible and elastic thermoplastic elastomer [col 17 lines 1-36] doll's garment having a molded shape to fit over external surfaces of at least a portion of a doll [Fig 18], has a through hole. Gross does not disclose a doll's garment formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 1 MN/M2).

Kramer teaches the concept of providing a doll, a doll's garment (col 1 lines 51-57) formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch (less than 1 MN/M2). It would have been obvious to modify the doll's garment of Gross to

have thickness and with modulus of elasticity as taught by Kramer to for greater flexibility.

With respect to the injection molded thermoplastic elastomer in claims 21-22, is considered to be process steps in product claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) [see MPEP 2113 regarding how product by process claims re treated in claims].

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gross in view of Kramer as applied to claims 21-23, 25, 28 and 30-34 above and further in view of Whitney et al [6,475,609], hereinafter Whitney.

Modified device of Gross has most of the elements of this claim but for a finish selected from the group consisting of paint, varnish, and glitter.

Whitney teaches that it is conventional to adhere glitter to the surface of or embedded in articles such as clothing to enhance their visual appearance [col 1 lines42-45]. It would have been obvious, in view of Whitney to even further provide modified the doll's garment of Gross with glitter in order to enhance their visual appearance.

7. Claims 20, 29 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross in view of Kramer as applied to claims 21-23, 25, 28 and 30-34 above and further in view of Yasuda [5,928,803].

Modified device of Gross has most of the elements of these claims but for the specific thermoplastic elastomer material.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls as the constituent element of dolls). It would have been obvious to further make the modified device of Gross out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

8. Claims 38-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross in view of Kramer and Yasuda.

Gross modified in view of Kramer discloses most of the elements of these claims but for the specific thermoplastic elastomer material.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls as the constituent element of dolls). It would have been obvious to further make the modified device of Gross out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

With respect to claim 46: it is generally well known to decorate garment with paint. Therefore, it would have been obvious to further modify the Gross's device to have paint for aesthetic reasons.

Art Unit: 3725

9. Claims 21-23, 25, 28 and 30-34 are rejected under 35 U.S.C. 103(a) as being obvious over O'Brian et al [2,944,368], hereinafter O'Brian in view of Kramer and either Gross or Wion [4,294,036].

O'Brian discloses in Figs 1-7, a garment [blouse 30] comprising a flexible and elastic molded thermoplastic elastomer [col 3 lines 54-56 and col 4 line 58 and also **[[re·sil·ient (rî-zîl'yent) adjective 1.** Capable of returning to an original shape or position, as after having been compressed.] according to Merriam-Webster's Collegiate Dictionary Tenth Edition] doll's garment having a molded shape to fit over external surfaces of at least a portion of a doll [Fig 4], has a through hole [insofar as the applicant has claimed blouse 30 is considered to have a through hole [the opening for the neck for example]]. Additionally, please note that O'Brian start with a flat sheet of material, which is then formed into three-dimension article.

O'Brian does not disclose that doll having articulated limbs as recited in claim 21 and 22, a doll's garment formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 1 MN/M2).

Kramer teaches the concept of providing a doll, a doll's garment (col 1 lines 51-57) formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch (less than 1 MN/M2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the doll's garment of O'Brian to have thickness and with modulus of elasticity as taught by Kramer to provide more flexibility.

Either Gross or Wion teaches that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of O'Brian with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more realistic and enjoyable for the children to play with.

With respect to the injection molded thermoplastic elastomer in claims 21-22, is considered to be process steps in product claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) [see MPEP 2113 regarding how product by process claims are treated in claims].

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brian et al in view of Kramer and either Gross or Wion as applied to claims 21-23, 25, 28 and 30-34 above and further in view of Whitney et al [6,475,609], hereinafter Whitney. Modified device of O'Brian has most of the elements of this claim but for a finish selected from the group consisting of paint, varnish, and glitter.

Whitney teaches that it is conventional to adhere glitter to the surface of or embedded in articles such as clothing to enhance their visual appearance [col 1 lines

Art Unit: 3725

42-45]. It would have been obvious, in view of Whitney to even further provide modified the doll's garment of O'Brian with glitter in order to enhance their visual appearance.

11. Claims 20, 29 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brian et al in view of Kramer and either Gross or Wion as applied to claims 21-23, 25, 28 and 30-34 above and further in view of Yasuda [5,928,803].

Modified device of O'Brian has most of the elements of these claims but for the specific thermoplastic elastomer material.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls as the constituent element of dolls). It would have been obvious to further make the modified device of O'Brian out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

12. Claims 38-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brian in view of Kramer, Yasuda and either Gross or Wion.

O'Brian modified in view of Kramer discloses most of the elements of these claim [see paragraph 5 above] but for the specific thermoplastic elastomer material and that doll having articulated limbs.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls as the constituent element of dolls). It would have been obvious to further make the modified device of O'Brian out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility. Either Gross or Wion teaches that it is conventional to have

articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of O'Brian with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more realistic and enjoyable for the children to play with.

With respect to claim 46: it is generally well known to decorate garment with paint. Therefore, it would have been obvious to further modify the O'Brian's device to have paint for aesthetic reasons.

13. Claims 21-23, 25-26, 28, 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian et al, hereinafter O'Brian and either Gross or Wion.

Kramer discloses most of the elements of these claims including a doll, a doll's garment (col 1 lines 51-57) formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch (less than 1 MN/M) and the doll's garment has a shape to fit over the external surfaces of at least a portion of the doll.

Kramer does not disclose that the doll's garment has a through hole, an elastic injection molded thermoplastic elastomer doll's garment and doll having articulated limbs as recited in claim 21 and 22, a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 26, the garment is less than 8 cm in height as recited in claim 28 and a play set comprising a doll wherein the doll is articulated at a

joint selected from the group consisting of the shoulders, elbows, knees, neck, and hips as recited in claim 34.

With respect to the doll's garment has a through hole to accommodate passage of a doll's head or limb(s), it is well known to make doll clothes that simulate real life, it would have been obvious to construct the doll clothing of Kramer such that it has a through hole for the head/limbs of the doll.

O'Brian in at least some of the embodiment such as Figs 2 and 3 teaches the concept of providing an elastic injection molded thermoplastic elastomer [col 4 line 58 and also [[**re·sil·ient** (rî-zîl'yent) adjective 1. Capable of returning to an original shape or position, as after having been compressed.] according to Merriam-Webster's Collegiate Dictionary Tenth Edition] and (col 3 lines 54-56)] doll's garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of the injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility.

Either Gross or Wion teaches that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of Kramer with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more enjoyable for the children to play with.

With respect to claim 26: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to further modify the Kramer's

device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

With respect to claim 28, it would have been obvious to further provide the garment of Kramer in the claimed height for the purpose of making the devices easier to play with and to accommodate for small dolls.

14. Claims 20, 29 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian and either Gross or Wion as applied to claims 21-23, 25-28, 30-34 and further in view of Yasuda.

Modified device of Kramer has most of the elements of these claims but for the specific thermoplastic elastomer material.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls as the constituent element of dolls). It would have been obvious to make the modified device of Kramer out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

15. Claims 38-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian, Yasuda and either Gross or Wion.

Kramer discloses most of the elements of these claims including a doll, a doll's garment (col 1 lines 51-57) formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch (less than 1 MN/M2).

Kramer does not disclose that the doll's garment has a through hole, an injection molded thermoplastic elastomer doll's garment, the specific thermoplastic elastomer material, and a play set comprising a doll and a doll's garments wherein doll is articulated at elbows and knees as recited in claims 38 and 47. Additionally, Kramer does not disclose a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 46.

With respect to the doll's garment has a through hole to accommodate passage of a doll's head or limb(s), it is well known to make doll clothes that simulate real life, it would have been obvious to construct the doll clothing of Kramer such that it has a through hole for the head/limbs of the doll.

O'Brian in at least some of the embodiment such as Figs 2 and 3 teaches the concept of providing injection molded thermoplastic elastomer (col 3 lines 54-56) doll's garment. It would have been obvious to use the teaching of the injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls (as the constituent element of dolls). It would have been obvious to further make the device of Kramer out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

With respect to claim 46: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to further modify the Kramer's

device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

Either Gross or Wion teaches that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of Kramer with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more enjoyable for the children to play with.

(10) Response to Argument

The appellant's first argument is that Claims 20-23, 25-26, and 28-51 are not indefinite under 35 U.S.C. 112, second paragraph. The rejection was made on the grounds that all that the all that the Appellants consider to be encompassed by the phrase "in a life-like way" cannot be determined. The Appellants note that this was a new rejection in the Appellants' second Appeal Brief raised only after the Appellants have appealed these claims and after the issuance of six (6) Official Actions directed to these claims containing the language at issue. Appellant argues that if the language at issue was truly indefinite, it would have been raised during at least one of the earlier six (6) Official Actions (when other 112 issues were raised). The Appellants submit that the rejection is both baseless and untimely. In response the examiner would like to point out that this is not the first time during the prosecution that this problem was raised, on the contrarily, the issue of indefinite language was first brought up on the office action mailed on 9/7/04. Additionally, there is nothing in the Rules preventing the examiner to

make a rejection after a filling of an appeal brief. What is required is that a rejection can be filed at any time during a prosecution as long as the applicant is given the proper time to respond which in this case the examiner has done by issuing a non final action on 3/28/06. Therefore, in this case, upon further review by the examiner it was determined that the claim language was not clear especially since it appears that the appellant is clearly attempting to narrow the claim language more than what it is by indicating that "the language at issue, namely "in a life-like way," is clear to those skilled in this art. This can be seen by placing the specific language at issue in the context of the rest of the claims in which it is used and by a simple reference to the Appellants' Specification and drawings", attempting to impart a special definition to the phrase ".a life-like way". Although, a patent practitioner may be his own lexicographer, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification."). Therefore, the term "in a life-like way" by itself and as broadly as claimed reads on a doll's garment that has normally and in a life like way has been dressed up. Nowhere in the specification has it been thought that the doll's garment has been "put on" in a life-like way (one can interpret the claim language as how the garment appears/fits on the doll).

In any event the appellant's argument is unconvincing since it does not clarify the scope of the claim.

For the reasons noted, the appellant first argument with respect to the indefiniteness rejection should be rejected.

Rejection of claims 21-23, 25, 28 and 30-34 under 35 U.S.C. §103(a)

The appellant's second argument is that the rejection claims 21-23, 25, 28 and 30-34 under 35 U.S.C. §103(a) over O'Brian in view of Kramer and either Gross or Wion should be reversed, because O'Brian discloses clothing as shown in Figs. 2 and 3 that is shaped to "snap" its hard plastic pieces onto a non-articulable doll such as a doll shown in Fig. 1. Such "snapping" action is a completely different mechanism to achieve positioning of clothing relative to the doll or a doll-like shape as compared to Kramer or as compared to the rejected claims, "snapping" an article on to a doll is not donning that article "in a life-like way" as claimed by the Appellants. "Snapping" is also not suggestive of "a life-like way." O'Brian therefore leads those skilled in the art away from the subject matter of the rejected claims. Additionally, O'Brian fails to disclose, teach or suggest injection molded thermoplastic elastomer. In response the examiner would like to point out that looking at Fig. 4 of the O'Brian reference it appears that the doll has been dressed up/fit in a life-like way (dressed up just like a human). Additionally, the material of O'Brian is resilient or capable of resuming its original shape after being expanded or compressed (as when the article of clothing is snapped on the doll); the material is in fact an elastomer (the attaching of the clothes to the body requires stretching as shown in figure 5). Furthermore, regarding the injection molded this is considered to be process steps in product claims. Even though product-by-process

claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) [see MPEP 2113 regarding how product by process claims are treated in claims].

Regarding the appellant's argument that the O'Brian approach is completely different from that of the rejected claims and Kramer, the examiner would like to point out that Kramer reference was only applied to show a doll's garment formed from a flexible sheet of polymer plastic material between 2 mm and 6 mm in thickness and with modulus of elasticity of less than 1 MN/M2.

Regarding the appellant's argument that one of ordinary skill in the art would have no incentive to make the hypothetical combination of O'Brian with Kramer in view of Gross. Gross fails to disclose, teach or suggest the cure for the deficiencies set forth above with respect to Kramer and O'Brian. In response, the examiner would like to point out that either Gross or Wion references was only applied to provide the modified device of O'Brian with the articulated the doll for the purpose of making the device more realistic and enjoyable for the children to play with. Additionally, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975).

However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Simon*, 174 USPQ 1 14 (CCPA 1972)., *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the ad, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. *In re Beattie*, 974 F.2d 1309, 24 USPQZd 1040 (Fed. Cir. 1992)', *In re Dillon*, 919 F.2d 688, 16 USPQZd 1897, 1905 (Fed. Cir. 1990)., *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976)', *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970).

In this case, the artisan would have been motivated to use the teaching of the injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility. Also, to further modify the device to make the doll articulate for the purpose of making the device more realistic and enjoyable for the children to play with.

Rejection of claim 26 under 35 U.S.C. §103(a)

Now referring to the appellant's comments regarding the rejection of claim 26 under 35 U.S.C. §103(a) over O'Brian in view of Kramer and either Gross or Wion as applied to Claims 21-23, 25, 28 and 30-34 and further in view of Whitney.

The examiner have already established that one skilled in the art would make the combination of Kramer, Gross or Wion with O'Brian; and Whitney is only applied to show that it is conventional to adhere glitter to the surface of or embedded in articles such as clothing to enhance their visual appearance.

Rejection of claims 20, 29 and 35-37 under 35 U.S.C. §103(a)

The appellant's next argument is that the rejection claims 20, 29 and 35-37 under 35 U.S.C. §103(a) over O'Brian in view of Kramer and either Gross or Wion as applied to claims 21-23, 25, 28 and 30-34 and further in view of Yasuda should be reversed, because one of ordinary skill in the art might very well hesitate to substitute the materials of Yasuda for the specific materials disclosed by O'Brian because substitution of such materials might destroy the "snap-on" ability of those garments as contemplated by O'Brian. In response the examiner would like to point out that the question under 35 USC j103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the ad at the time the invention was made. See Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 10 USPQZd 1843 (Fed. Cir. 1989) and In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the ad to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves', a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the ad without any

specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). j

In this case, the artisan would have been motivated to make the modified device of O'Brian out of thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

Rejection of claims 38-51 under 35 U.S.C §103(a)

The appellant's next argument is that the rejection of claims 38-51 under 35 U.S.C. §103(a) over O'Brian in view of Kramer, Yasuda and either Gross or Wion should be reversed by stating that the Appellants have already demonstrated why one skilled in the art would not combine O'Brian in view of Kramer in view of Yasuda and either Gross or Wion presented above. The examiner also would like to refer back to her responses as stated above that one skilled in the art would indeed make the combination.

Rejection of claims 21-23, 25-28 and 30-34 under 35 U.S.C. §103(a)

Turning now to the appellant's next argument that appellants have already discussed the complete inapplicability of both Gross and Kramer when taken alone. The appellants respectfully submit that one skilled in the art would have no incentive to hypothetically combine Kramer with Gross. Gross relates to a doll that has expandable bladders. This is sharply contrasted to the essentially two-dimensional bath tub use of figures that are applied to tile through water adhesion. Moreover, there is nothing in

Kramer that in any way teaches or suggests that the alleged flexibility of the sheets of polymer plastic would in any way be suitable to be applied to the dolls of Gross. The Kramer pieces are planar pieces that are in no way intended to be wrapped around or fitted over a doll, whether elastically or not. Reversal of the rejection is respectfully requested.

These arguments have been addressed above. The examiner maintains that Kramer is being provided for the teaching of a doll's garment formed from a flexible sheet of polymer plastic material between 2 mm and 6 mm in thickness and with modulus of elasticity of less than 1 MN/M2 and Gross discloses in Fig 18, a garment [jumpsuit 180] comprising a flexible and elastic thermoplastic elastomer that can be "put on" in a life like way.

Rejection of claims 20, 29 and 35-37 under 35 U.S.C. §103(a)

Appellant's next arguments toward Gross, Kramer and Yasuda have been addressed above. The examiner maintains her rejection.

Rejection of claims 38-51 under 35 U.S.C. §103(a)

Appellant's next arguments toward Gross and Kramer have been addressed above. The examiner maintains her rejection.

Rejection of claims 21-23, 25-26, 28 and 30-34 under 35 U.S.C. §103(a)

Appellant's following arguments toward O'Brien and either Gross or Wion have been addressed above. The examiner maintains her rejection.

Rejection of claims 20, 29 and 35-37 under 35 U.S.C. §103(a)

Appellant's next arguments toward Kramer, O'Brien and either Gross or Wion and Yasuda have been addressed above. The examiner maintains her rejection.

Rejection of claims 38-51 under 35 U.S.C. §103(a)

Appellant's next arguments toward Kramer, O'Brien, Yasuda and either Gross or Wion have been addressed above. The examiner maintains her rejection.

For the reasons noted, the appellant arguments with respect to the obvious rejections should be rejected.

Additional Arguments

With respect to the appellant's arguments starting on page 25 of the brief, which are directed to secondary consideration of obviousness the examiner responds as follows:

Appellant has failed to set forth the following conditions to prove the criticality of the limitations of the claims and overcome the outstanding rejections:

a] the disclosure and claims of the patent application do not establish a nexus between the claimed invention and the alleged commercial success because there is no evidence that the product which has been sold corresponds to the claimed invention, or that the commercial success is attributable to the product defined by the claims.

b] it has not been determined that the commercial success alleged is directly derived from the invention, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business event extraneous to the merit of the claimed invention.

c] appellant has not shown that the claimed features were responsible for the commercial success.

For the reasons noted, the appellant arguments with respect to the secondary consideration of obviousness should be rejected.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully Submitted,

Faye Francis



Conferees:

Joe Hail



Derris Banks



Application/Control Number: 09/844,322
Art Unit: 3725

Page 24